



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,224	05/24/2001	Donald Steiner	2101950-991110	5883

7590

03/05/2004

ANDRE M GIBBS
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,224

Applicant(s)

STEINER ET AL.

Examiner

Susan Y Chen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 6-10, 17-23 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10, 17-23 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Status

1. This office action is in response to the amendment file on 02/17/2004. Applicants have amended claims 6-10, 17-23 and 32-37 without traverse for continue prosecution, and canceled claims 1-5, 11-16 and 25-31.

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation are requested in correcting any errors of which applicants may become aware in the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 6, is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/895,646. Although the conflicting claims are not identical, they are not patentably distinct from each other. Because claim 6 of instant application is a near verbatim reproduction of claim 1 of the '590 application, except that instead of claiming a narrower subject matter—register a weight vector of requestor as by the '646 application, the instant application cited a broader subject matter—register a resource provider.

Since the difference of the claimed subject matters in scope is *de minimis* and unrelated to the overall aesthetic appearance of the claims being compared; and it is well known in the database art, to register a weight vector of a resource provider as *de minimis* to register a resource provider, such that, the system can use it to feedback and re-rank a document. For example, see Chidlovskii et al. (U.S. Patent No. 6,327,590; col. 8, lines 39-60). Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the '646 application invention by registering a resource provider as claimed at current application, because by doing so, the subject matter of the instant claim 6 would have been a *prima facie* obvious in view of the above noted claim 1 of '646 invention.

This is a provisional obviousness-type double patenting rejection.

Art Unit: 2171

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19-23 and 34-37, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claims 19 and 34, the claimed subject matter "instructions for generating at said search broker a registration database for said resource provider" is indistinct, since applicant fails to disclose how to generate at search broker a registration database for the resource provider. In order to continue prosecuting the instant application, the examiner regards the claimed subject matter as a URL repository of resource document collections.

As to claims 20-23 and 35-37, these claims have the same defect as their base claims, hence are rejected for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

Art Unit: 2171

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 6-10, 17-23 and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Chidlovskii et al. (U.S. Patent No. 6,327,590, hereinafter referred as Chidlovskii).

As to claim 6, Chidlovskii discloses a computer program product for use in conjunction with a distributed network [e.g., the internets (110, 106, Fig. 1), col. 4, lines 1, 8-9] comprising a resource requestor [e.g., the client computer (102, Fig. 1); col. 4, line 2], at least one search broker [e.g., the various search engines (20, 80, Fig. 2), col. 4, line 27] and at least one resource provider [e.g., the meta-search engine (80, Fig. 2), the user / community profilers (60, 70, Fig. 2), col. 4, lines 32-40, etc.], the computer program product [e.g., the distributed operating environment system of Fig. 1] comprising a computer readable storage medium [e.g., the heterogeneous databases, col. 5, line 36] and a computer program mechanism [e.g., the distributed operating environment mechanism of Fig. 1, including the application program interface(API, col. 5, lines 11-14), the Wrapper tool (col. 5, line 15-16), the community administrator (col. 7, lines 17-18), etc.] embedded therein, the computer program mechanism comprising:

a) first instructions for sending a resource query executable by said resource requester [e.g., the query (102, Fig. 2) issued by the user(100, Fig. 2), col. 4, lines 1-15];

b) second instructions executable by said search broker [e.g., the heterogeneous search engines, col. 1, lines 47-48] for registering said resource provider [e.g., the heterogeneous information provider distribute over the Web, col. 1, line 51; Note: Heterogeneous information providers must register with heterogeneous search engines to publish resource information at the Internet];

c) third instructions executable by said search broker for finding said resource provider matching said resource query [col. 1, lines 45-56];

d) fourth instructions executable by said search broker for sending said resource query to said resource provider [e.g., the search engine submits the query to the heterogeneous database; see col. 1, lines 50-56; col. 5, lines 33-39; Fig. 2]; and

e) fifth instructions executable by said resource provider for finding resources available matching said resource query [col. 2, lines 49-51; col. 5, lines 48-55].

As to claim 7, except the features recited in claim 6, Chidlovskii further discloses the sixth instructions executable by said resource provider for sending search results to said resource requester [e.g. col. 5, lines 19-22].

As to claim 8, except the features recited in claims 7, Chidlovskii further discloses the seventh instructions executable by said resource provider for finding search brokers in said computer network [e.g., col. 2, lines 36-43; col. 5, lines 42-55].

As to claim 9, except the features recited in claims 8, Chidlovskii further discloses the eighth instructions executable by said resource provider for obtaining a resource description [e.g., col. 1, lines 50-56; 80, Fig. 2].

As to claim 10, except the features recited in claim 6, Chidlovskii further discloses the ninth instructions executable by said resource provider [e.g. the API or the wrapper, col. 5, lines 11-26] for sending a resource query to a computer coupled to said resource provider [e.g., col. 5, lines 11-26, 33-37].

As to claim 17, Chidlovskii discloses a computer program product for use in conjunction with a distributed network [e.g., the internets (110, 106, Fig. 1), col. 4, lines 1, 8-9] comprising a resource requestor [e.g., the client computer (102, Fig. 1); col. 4, line 2], at least one search broker [e.g., the proxy server (112, Fig. 1, col. 4, lines 6-15), the various search / meta-search engines (20, 80, Fig. 2), col. 4, line 27] and at least one resource provider [e.g., the user / community profilers (60, 70, Fig. 2), col. 4, lines 32-40], the computer program product [e.g., the distributed operating environment system, Fig. 1] comprising a computer readable storage medium [e.g., the heterogeneous databases, col. 5, line 36] and a computer program mechanism [e.g., the distributed operating environment mechanism of Fig. 1, including the application program interface (API, col. 5, lines 11-14), the Wrapper tool (col. 5, line 15-16), the community administrator (col. 7, lines 17-18), etc.] embedded therein, the computer program mechanism comprising:

a) first instructions for registering said resource provider [e.g., the heterogeneous information provider distribute over the Web, col. 1, line 51] with said search broker [e.g., the heterogeneous search engines, col. 1, line 47-48; Note: Heterogeneous information providers must register with heterogeneous search engines to publish resource information at the Internet].

b) second instructions for sending a resource query [e.g., the query (102, Fig. 2)] from said resource requester [e.g., the user (100, Fig. 2)] to said search broker [e.g., the meta-search engine (80, Fig. 2)];

c) third instructions for sending said resource query from said search broker to said resource provider [e.g., the search engine submits the query to the heterogeneous database; see col. 1, lines 50-56; col. 5, lines 33-39; Fig. 2];

d) fourth instructions for searching said resource provider for local resources based on said resource query; and

e) fifth instructions for sending search results from said resource provider to said resource requestor [e.g., the meta-search wrapper scans the HTML files returned by the search engine and return to the user; see col. 5, lines 16-26].

As to claim 18, except the features recited in claim 17, Chidlovskii further discloses the sixth instructions for sending said resource query [e.g., the query of some client computers (102, Fig. 1) located on an Intranet (100, Fig. 1)] from said resource provider [the proxy server 112, Fig. 1] to a computer [e.g., the servers 104, Fig. 1] coupled to said resource provider [e. g. Fig. 1; col. 4, lines 1-15].

As to claim 19, except the features recited in claim 17, Chidlovskii further disclose the sixth instructions for generating at said plurality of search brokers registration databases for said plurality of resource providers [e.g., the URL repository of resource document collections, col. 8, line 50].

As to claim 20, except the features recited in claim 19, Chidlovskii further discloses the seventh instructions for determining whether said resource provider contains a resource matching said resource query [e.g., col. 2, lines 49-51; col. 5, lines 48-55; col. 8, lines 49-51].

As to claim 21, except the features recited in claim 20, Chidlovskii further discloses the resource query comprises a keyword [e.g. the user defined key words t_i are keywords of user profile which was used as resource query to meta-search engine 80, Fig. 2; col. 8, lines 35-38].

As to claim 22, except the features recited in claim 21, Chidlovskii further discloses the eighth instructions for selecting said resource provider based on said keyword of said resource query [e.g., col. 6, lines 65 – col. 7, line 6].

As to claim 23, except the features recited in claim 22, Chidlovskii further discloses the ninth instructions for ranking said search results at said resource requester [e.g., col. 8, lines 26-46].

As to claim 32, Chidlovskii discloses a computer program product for use in conjunction with a distributed network comprising a resource requestor, a plurality of search brokers and a plurality of resource providers, the computer program product comprising a computer readable storage medium and a computer program mechanism embedded therein, the computer program mechanism comprising:

a) first instructions for registering said plurality of resource providers [e.g., the heterogeneous information provider distribute over the Web, col. 1, line 51] with said plurality of search brokers [e.g., the heterogeneous search engines, col. 1, line 47-48; Note: Heterogeneous information providers must register with heterogeneous search engines to publish resource information at the Internet];

b) second instructions for sending a resource query [e.g., the query (102, Fig. 2)] from said resource requester [e.g., the user (100, Fig. 2)] to at least a subset [e.g., the meta-search engine (80, Fig. 2)] of said plurality of search brokers [e.g., the heterogeneous search engines, col. 1, line 47-48] ;

c) third instructions for sending said resource query from said subset of said plurality of search brokers [e.g., the meta-search engine (80, Fig. 2)] to at least a subset of said plurality of resource providers [e.g., the community document collection (70, Fig. 2)];

d) fourth instructions for searching for local resources based on said resource query [e.g., the wrapper used by the meta-searcher that scans the HTML files by the search engine and create (or find) an HTML file for local user viewing based on the resource query; see col. 1, lines 45-56; col. 5, lines 16-26; col. 6, lines 15-26]; and

e) fifth instructions for sending search results from said subset of said plurality of resource providers to said resource requester [e.g., the meta-search wrapper scans the HTML files returned by the search engine and return to the user; see col. 5, lines 16-26].

As to claim 33, except the features recited in claim 32, Chidlovskii further discloses the sixth instructions for sending said resource query from a resource provider to a computer coupled to said resource provider [e.g., col. 4, lines 1-15].

As to claim 34, except the features recited in claim 32, Chidlovskii further disclose the sixth instructions for generating at said plurality of search brokers registration databases for said plurality of resource providers [e.g., the URL repository of resource document collections, col. 8, line 50].

As to claim 35, except the features recited in claim 34, Chidlovskii further discloses the seventh instructions for determining whether said subset of said plurality of resource providers contains a resource that matches said resource query [e.g., col. 2, lines 49-51; col. 5, lines 48-55; col. 8, lines 49-51].

As to claim 36, except the features recited in claim 35, Chidlovskii further discloses the resource query comprises a keyword [e.g. the user defined key words t_i are keywords of user profile which was used as resource query to meta-search engine 80, Fig. 2; col. 8, lines 35-38].

As to claim 37, except the features recited in claim 35, Chidlovskii further discloses the eighth instructions for selecting a resource provider based on said keyword of said resource query [e.g., col. 6, lines 65 – col. 7, line 6].

Conclusion

6. To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shoroff et al. (U.S. Patent No. 6,381,602) which discloses systems and methods for enforcing access control on secured documents provided by external information providers; Teper et al. (U.S. Patent No. 5,815,665) which discloses

Art Unit: 2171

online brokering service provides user authentication and billing services over distributed public network.

Inquiry

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Chen
March 2, 2004

SLC 3/2/04